



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,284	04/09/2004	Bradley Moore	DEP5292	1111
27777 7590 09/05/2008 PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003				
EXAMINER HOFFMAN, MARY C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
09/05/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/821,284

**Applicant(s)**

MOORE ET AL.

**Examiner**

MARY HOFFMAN

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-47 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 37-47 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 16 October 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/08/2008 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 37-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pagliuca et al. (US 2003/0073998) in view of Chin (US 2005/0065517, see Provisional Application 60518580) and Koros et al. (US 5,928,139).

Pagliuca et al. disclose a minimally invasive surgical method comprising making a first incision in a patient; inserting a retractor and expanding it, advancing a first anchor through (a first pathway) via the expanded retractor to a first anchor site on a first vertebra; and advancing a second anchor through the expanded

retractor to a second anchor site on a second vertebra adjacent the first vertebra.

Pagliuca further discloses positioning a first end of a spinal rod in the expanded retractor; advancing the first end of the spinal rod subcutaneously; and coupling the spinal rod to the first anchor, the second anchor, and the third anchor. Disk material is removed from the disk space between the first and second vertebrae through the first pathway, the method further comprising inserting bone graft into the disk space, the method further comprising inserting an interbody fusion device into the disk space (FIG. 70, claim 14).

Pagliuca et al. disclose the claimed invention except for 1.) making a percutaneous incision in the patient; creating a second pathway to the third vertebra by dilating the incision and inserting a cannula/percutaneous access device having an opening to facilitate coupling to the fixation element, advancing a third anchor through the percutaneous incision to a third anchor site on the third vertebra; advancing the first end of the fixation element subcutaneously/subfascially to the third anchor; and advancing a closure mechanism through the lumen of the percutaneous access device and further comprising a second fixation element, and a fourth, fifth, and a sixth anchor, and 2.) the retractor having a plurality of expandable retractor blades and expanding the retractor by separating the retractor blades to allow the first end of the fixation element to pass therethrough.

Chin discloses making a percutaneous incision in the patient; creating a second pathway to the third vertebra by dilating the incision and inserting a cannula/percutaneous access device having an opening to facilitate coupling to the

fixation element, advancing a third anchor through the percutaneous incision to a third anchor site on the third vertebra; advancing the first end of the fixation element subcutaneously/subfascially to the third anchor; to perform minimally invasive surgery.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to perform the method of Pagliuca et al. making a percutaneous incision in the patient; creating a second pathway to the third vertebra by dilating the incision and inserting a cannula/percutaneous access device (see FIGS. 2a-b) having an opening to facilitate coupling to the fixation element, advancing a third anchor through the percutaneous incision to a third anchor site on the third vertebra; advancing the first end of the fixation element subcutaneously/subfascially to the third anchor (See FIG. 9); and advancing a closure mechanism through the lumen of the percutaneous access device in view of Chin to perform minimally invasive surgery.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the method of Pagliuca in view of Chin using a second fixation element, and a fourth, fifth, and a sixth anchor, since it has been held that mere duplication involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

2.) Koros et al. disclose using a retractor having a plurality of expandable retractor blades and expanding the retractor by separating the retractor blades to allow the first end of the fixation element to pass therethrough in order to provide an improved retractor for use in spinal surgery.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to perform the method of Pagliuca with a retractor having a plurality of expandable retractor blades and expanding the retractor by separating the retractor blades to allow the first end of the fixation element to pass therethrough in view of Koros et al. in order to provide an improved retractor for use in spinal surgery.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARY HOFFMAN whose telephone number is (571)272-5566. The examiner can normally be reached on Monday-Thursday 10:00-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mary C. Hoffman/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733